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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,410	10/24/2003	Irma Blancas		2076

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Irma Blancas, Pathway Enterprises, Inc
936 Brady
San Antonio, TX 78207

EXAMINER

RAHMJOO, MANUCHER

ART UNIT	PAPER NUMBER
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2624

MAIL DATE	DELIVERY MODE
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05/25/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	10/693,410		BLANCAS, IRMA	
	Examiner		Art Unit	
	Mike Rahmjoo		2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 1-3, 5-16 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4, 17, 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 4,17-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claims 4 applicant claims providing an item for said individual to use with means of dislodging or removing external objects on an individual's fingertips prior to a fingerprint scan whereby said method increases the confidence of a fingerprint or fingertip scan to identify an individual in the enrollment process; and as per claims 17-18 applicant claims providing an individual to inspect another individual prior to a fingerprint scan comprising of:

1. inspecting said individual's fingertips;
2. providing an item for said individual to use with means of cleaning their fingers or fingertips prior to a fingerprint scan;
3. allowing said individual to update a password (or a PIN) if said individual's fingerprint scan matches an authorized template whereby said method increases the trustworthiness of a fingerprint or fingertip scan to identify an individual for authorization of an action.

The claimed invention as a whole must be useful and accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966); In re Fisher, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); In re Ziegler, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). As such examine fails to see any "useful, concrete and tangible results" as claimed by applicant.

Examiner reviewed the application to identify any asserted use. The applicant is in the best position to explain why an invention is believed useful. Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful. Such a statement will usually explain the purpose of the invention or how the invention may be used. Regardless of the form of statement of utility, it must enable one ordinarily skilled in the art to understand why the applicant believes the claimed invention is useful. See MPEP § 2107 for utility examination guidelines. Applicant also claims such limitations such as "allowing said individual...". Said step(s) are merely descriptive without reaching a final result as "useful, concrete and tangible" as claimed by applicant and are therefore rejected under 35 U.S.C. 101.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 4 and 17- 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Pu et al (US PAP 2003/ 0105966), hereinafter, Pu.

As per claims 4 and 17- 18 Pu teaches allowing said individual to update a password (or PIN) (corresponding to for example changing a password/ user ID at a later time in [0027]) if said individual's fingerprint scan matches an authorized template (corresponding to for example matching through fingerprint template in [0043]) whereby said method increases the trustworthiness of a fingerprint or fingertip scan to identify an individual for authorization of an action corresponding to for example the title and the abstract and [0027].

However, Pu does not inspecting said individual's fingertips; providing an item for said individual to use with means of cleaning their fingers or fingertips prior to a fingerprint scan; and providing an item for said individual to use with means of dislodging or removing external objects on an individual's fingertips prior to a fingerprint

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scan whereby said method increases the confidence of a fingerprint or fingertip scan to identify an individual in the enrollment process.

It is well known in the art to inspect said individual's fingertips; provide an item for said individual to use with means of cleaning their fingers or fingertips prior to a fingerprint scan; and provide an item for said individual to use with means of dislodging or removing external objects on an individual's fingertips prior to a fingerprint scan whereby said method increases the confidence of a fingerprint or fingertip scan to identify an individual in the enrollment process.

It would have been made obvious to one of ordinary skilled in the art at the time the invention was made to incorporate inspecting said individual's fingertips; providing an item for said individual to use with means of cleaning their fingers or fingertips prior to a fingerprint scan; and providing an item for said individual to use with means of dislodging or removing external objects on an individual's fingertips prior to a fingerprint scan whereby said method increases the confidence of a fingerprint or fingertip scan to identify an individual in the enrollment process to provide proper readings/ scan of fingerprints and therefore increase the degree of reliability of said readings/ scan of said fingerprints by lowering errors which would otherwise surface due to lack of inspections/ clean fingertips.

Examiner would suggest clearly claiming said limitations as per claims 4, 17- 18 as pertaining to specific functions (e.g., updating a password). The language currently used does not clearly claim applicant's claimed invention as it may be recited throughout the specification.

Response to Arguments

Applicant's arguments filed 04/19/2007 have been fully considered but they are not persuasive.

In response to applicant's arguments on page 9 wherein argues the 35 USC 101 rejection, examiner points out the limitations as claimed (e.g., providing an item for said individual) do not present any practical application.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Nonfunctional descriptive material that does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. Sec. 101. Certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data, without any functional interrelationship is not a process, machine, manufacture or composition of matter. USPTO personnel should be prudent in applying the foregoing guidance. Nonfunctional descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. Sec. 101. The presence of the claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter. For example, a computer that recognizes a particular grouping of musical notes read from memory and upon recognizing that particular sequence, causes another defined series of notes to be played, defines a functional interrelationship among that data and the computing processes performed when utilizing that data, and as such is statutory because it implements a statutory process.

Claims 4 and 17- 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 17, for example, recites "allowing said individual to update a password if said individual's fingerprint scan matches an authorized template" which does not impart functionality to a computer or computing device, and is thus considered nonfunctional descriptive material. Such nonfunctional descriptive material, in the absence of a functional interrelationship with a

computer, does not constitute a statutory process, machine, manufacture or composition of matter and is thus non-statutory per se.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6941001 combines the functionality of a computer pointing device with a fingerprint authentication system. In the preferred embodiment, by regularly scanning fingerprints acquired from the pointing device touch pad, fingerprint features may be extracted and compared to stored data on authorized users for passive authentication. Furthermore, calculations based upon the acquired fingerprint images and associated features allows the system to determine six degrees of freedom of the finger, allowing the user to control a variety of functions or to manipulate a three-dimensional model or virtual reality system.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Rahmjoo whose telephone number is 571-272-7789. The examiner can normally be reached on 8 AM- 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matt Bella can be reached on 571-272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mike Rahmjoo

May 21, 2007



MATTHEW C. BELLA
SUPERVISORY PATENT EXAMINER
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